

REMARKS

In the Office Action of January 29, 2004, the rejection of independent claim 1 on of Komiya U.S. Patent No. 6,155,025 under 35 USC 102(e) was made final.

In the office action it is conceded that the reference does not explicitly disclose the "means to translate" limitation and is asserted that this limitation is met under principles of inherency, which is governed by the law set out in MPEP 2112, which provides (at 2100-52):

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).... \*\*\*

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The office action does not provide any evidence that establishes that the recited connecting means is necessarily present in the apparatus described in Komiya.

Applicant relies on the accompanying Rule 132 Declaration of Paul Mills, who has nine years of experience in computerized packaging system control. (Mills Declaration, ¶1).

As is explained by Mr. Mills, Komiya does not explicitly describe a system with a "connecting means" and "means to translate." (Mills Declaration, ¶7). Mr. Mills further testifies: "[T]here is no reason to assume from what is said in Komiya that the system

described in Komiya would have "respective connecting means," each of which includes "means to translate data bus commands appropriate to that component into a command protocol which is read by the connected component" such that the control means is able to control each of the connected components independent of command protocols recognized by the connected components." "(Mills Declaration, ¶7).

Mr. Mills addresses the passages cited in the office action in ¶8 and further considers the following rationale stated in the office action in ¶9:

Note that KOMIYA ET AL. does not specifically refer to the data bus that transmits signals and translations of commands from the controller to the peripheral units, however, these limitations are inherent in the invention of KOMIYA ET AL: the connecting of a elements of a machine with a controller, such as connecting a printer or floppy drive to a computers CPU or connecting remote sensors and machine control circuits to a PLC, is inherent in structure and is necessary when any components are connected via a data bus to a controller. The same principle applied to a means for translating date bus commands: if this were not so, the above examples of a computer would not be able to communicate with or recognize the printer of floppy drive and the example of a machine with remote sensors and control circuits would not be able to communicate or receive instructions from the PLC.

Mr. Mills then explains why this rationale is in error in ¶10:

I disagree with the examiner's conclusion. There is no reason to assume that each component has a "respective connecting means" with a means to translate the data bus commands to commands appropriate to the specific device. Instead, it is more likely to assume Komiya envisaged that if an item of equipment were to be replaced, it would be replaced by an item which operates according to the same protocol (as the one being replaced) or else, that the computer controller is reprogrammed (e.g., to use a new driver for the new component) to cope with such a new item of equipment.

While one might speculate that, if one wanted to, one could implement Komiya's system such that it had such a means to translate, such speculation does not establish that the Komiya system *necessarily* has such a means to translate, as is required under the *Rijckaert* and *Ex parte Levy* authorities cited in MPEP 2112 for inherent disclosure. Indeed, as is clear from Mr. Mills statement, far from being necessarily present, it is more

Applicant : Paul Mills  
Serial No. : 09/728,395  
Filed : December 1, 2000  
Page : 4 of 4

Attorney's Docket No.: 11033-063001 / A9942US-DJL

likely that the Komiya system would be implemented differently. In any event, speculation does not establish anticipation by inherency.

Accordingly the rejection under 35 USC 102(e) under principles of inherency cannot stand and should be withdrawn.

It is respectfully submitted that the rejection of claim 1 on Komiya should be withdrawn, and that claim 1 should be allowed. The remaining claims depend on claim 1 and are allowable with it.

Enclosed is a \$770 check for request for continued examination and a \$110 check for the Petition for Extension of Time fee.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

May 27, 2004

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